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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re the Application of:

Masaharu Iwai et al.

Serial No.: **09/868,907**

Filed: **July 9, 2001**

For: **MAGNET ROLLER**



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TECHNOLOGY CENTER 2800
Confirmation No.: 1290

Group Art Unit: 2832

Examiner: **Lincoln Donovan**

Attorney Docket: 010879

RESPONSE AFTER FINAL REJECTION

***** expedited procedure *****

Commissioner for Patents
Washington, D.C. 20231

Date: **September 24, 2003**

Sir:

In response to the Final Office Action mailed on June 24, 2003:

Rejection under §112: At the personal interview of September 10, the Examiner invited the undersigned attorney to present arguments against the rejection. The Examiner had rejected claims 1 and 4 on the basis that the "acute" angles were not directed. The Applicants' arguments in traverse follow:

Claim 4 recites that the "the sum of the angles of the directions of orientation magnetization [is] less than 90°," and this is only possible if the summed angles are all acute. Claim 4 also recites that the angles of the orientation magnetization directions are defined "relative to the adjacent adjoining face." Because of the word "adjacent," and because this face is recited in the singular, it must be the case that the summed acute angles are next to each other.

Since there are just two angles,¹ each referred to the same line (the joining face), and the acute angles are adjacent, the directivity of the angles recited in claim 4 is well-defined.

The Examiner is authorized to make an examiner's amendment to line 7 of claim 4 so that it would recite "by setting the sum of the adjacent angles ..." if the Examiner believes this would clarify the claim language.

Claim 1 also recites that the two angles are acute, and further recites that the directions of the orientation magnetization "converge." As was discussed at the personal interview, the word "converge" implies at least that the magnetizations are similarly oriented with regard to acute/obtuse, so that the two acute angles must be adjacent. (The word "converge" also has a further meaning, which is discussed below.)

Withdrawal of the rejection is requested.

Rejection under §103: Regarding the term "converging" in claim 1, the Examiner stated at the interview that this term might cover not only the magnetization shown in the upper half of the Applicants' Fig. 3, but also the magnetization shown in the upper half of the Applicants' Fig. 4 (or, in Fig. 8A of the Kan reference).

The word "converge" appears in the Detailed Description of the instant specification on page 18 (lines 10, 15, and 24), and that text describes Fig. 3, but *not* Fig. 4. The only exception is that "converge" also appears in the final two summarizing paragraphs of the Detailed Description (page 27, line 25 and page 28, line 2).²

The text on page 18, lines 6-10, reads, "As shown in Fig. 3, [f]irst magnetic piece 42 is subjected to orientation magnetization that *converges* as shown by arrow 44 second magnetic

¹At any point along the line of extension, there exactly two directions of orientation magnetization, since the magnetization inside a magnet is continuous, and the line of extension must be bordered by exactly two magnets.

²The undersigned attorney determined this by a word search of a computer file of the application.

piece 48 is subjected to orientation magnetization that *converges* as shown by arrow 49" (italics added). The magnet pieces in Fig. 4, that correspond to magnet pieces 42 and 48 in Fig. 3, are labeled as 52 and 51; the quoted passage does not refer to Fig. 4. The discussion of Fig. 4 starts on the next page, at line 3.

The Examiner is now asked to consider that, because "converge" is used in the specification to describe only Fig. 3 and not Fig. 4, it follows that "converging" in the claims is *defined* by the Applicants' specification to exclude the subject matter of Fig. 4 (and any similar prior art).

MPEP §2173.05 refers to "the well-established axiom in patent law that a patentee or applicant is free to be his or her own lexicographer when there is more than one definition of a term, [the applicant should] make clear which definition is being relied upon to claim the invention."

The Examiner stated at the interview that "converging" might be interpreted in two ways, to cover Fig. 3 or Fig. 4. Assuming that is correct, the Applicants have made it perfectly clear which of the two definitions should be applied to the claims, by using the claim term to refer only to Fig. 3 and not to Fig. 4 which is similar except for relative orientations of the arrows 44.

Thus, "converging" in claim 1 covers the subject matter illustrated in Fig. 3, and not that illustrated in Fig. 4. Therefore Fig. 8A of Kan does not show converging magnetization, and neither does any of the other applied art.

Withdrawal of the rejection is requested.

*GAU 2832, Ser. No. 09/868,907
O.A. of June 24, 2003
Amendment of September 24, 2003*

If this paper is not timely filed, then this paper is a petition for an appropriate extension of time. Fees which may be due with respect to this paper may be charged to Deposit Account No. 01-2340.

Respectfully submitted,

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